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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,708	06/16/2006	Stefan Bracht	RO4101US	5800
7590 D Peter Hochberg 6th Floor 1940 East 6th Street Cleveland, OH 44114			EXAMINER GHALL, ISIS A D	
			ART UNIT	PAPER NUMBER
			1611	
			MAIL DATE	DELIVERY MODE
			02/03/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/553,708

Applicant(s)

BRACHT, STEFAN

Examiner

Isis A. Ghali

Art Unit

1611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-4, 9, 10, 12-14 and 16-20
Claim(s) withdrawn from consideration: 5-8, 11 and 15

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/Isis A Ghali/
Primary Examiner, Art Unit 1611

The amendment made to claim 17 has overcome the 112/first paragraph

The following rejections are maintained:

Rejection of claim 19 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Rejection of claims 1-4, 9, 10, 12-14, 16-20 under 35 U.S.C. 102(b) as being anticipated by Degen (DE 10053375) as evident by the provided articles: "4-aminobenzoic acid", encyclopedia, "CINNAMIC ACID", product identification, "Benzophenone", IngredientsFeedbackScience, and "Lacquer definition", Your Dictionary.

Applicant argues that claim 19 has support in paragraph 0022 for incorporation of dye and pigments into the backing. Recourse to paragraph 0022, the paragraph emphasize coating of the pigments or dye to the surface of the backing averted from skin to avoid contact of the dye or pigment with the drug-containing matrix. Therefore, the disclosure support coating of the backing layer with pigment/dye and contradict inclusion or incorporation of the pigment/dye into the backing.

Applicant argues that Degen does not teach every element of the claims. The Examiner states in the Final Office action (page 5, lines 1-2) that "UV absorbers disclosed by the reference read on dyes or pigments since all of them have color (white)." The Applicant disagrees with this position. The fact that a substance has a color is not sufficient for qualifying it as a dye or pigment. Any substance, at least when present in solid or powdered form, has some "color" otherwise it would be invisible. However, it is also known to those skilled in the art that not all substances are thus suitable as dyes or pigments. Degen, nor any other prior art of record, teach that the colorless UV absorbers of Degen are suitable as pigments. The UV absorbers are not "white in color" but merely have a white appearance when present as crystals. Moreover, Degen fails to teach crystals at all.

In response to this argument, applicants' attention is directed to the scope of the present claims that are directed to a product, and all the elements of the product are taught by Degen's reference. The present claims are not directed to any specific dye or pigment, and claimed lightness color values L1 are broad from 50 to 200% of L2, and L2 is from 5° to 100°. The claims further recite "second or any other person" which encompasses almost any skin color. Applicant admits that the UV absorbers taught by the reference are white in color, and white is a color. Words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). In the present case, applicants did not define the terms "dye or pigment".

Therefore, pigment can be black or white and Degen teaches UV absorbers that are known to be white. Hence, the reference implies the presence of the white color in the matrix and backing layer as instantly claimed. Degen claims transparent patch including transparent reservoir and backing, and preferred "colorless-transparent". This implies the presence of non-transparent and colored backing and reservoir. In other words, the reference does not exclude colored backing and reservoirs, however, Degen preferred the colorless-transparent. Further the present claims' language "containing" does not exclude the presence of transparent backing containing colored materials as disclosed by Degen. The disclosed examples and preferred embodiment do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The presence of color is implied by Degen by teaching presence of UV absorber that are white in color.